

REMARKS

Claims 1-12 have been examined. With this amendment, Applicant adds claims 13-32.

I. Statement of Substance of Interview

Please review and enter the following remarks summarizing the interview conducted on November 3, 2004:

An Examiner's Interview Summary Record (PTO-413) was attached with the Office Communication dated November 16, 2004.

During the interview, the following was discussed:

1. Identification of claims discussed: Claim 1.
2. Identification of art discussed: Sakai *et al.*
3. Indication of other pertinent matters discussed: Examiner gave further clarification of Examiner's rejection of Claim 1 with respect to Sakai *et al.*

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

II. Request to Withdraw Finality of Office Action based on Interview Summary

On November 3, 2004, Applicant's representative conducted an interview to request clarification of the rejection in this Office Action. Clarification of the rejection was needed because, other than in the Examiner's Response to Arguments section, the Office Action merely cited large sections of the prior art without clearly communicating "the findings, conclusions and reasons which support them" as required by the MPEP. See MPEP 2100-22 (emphasis added).

Even in the Response to Arguments section, the Examiner's contentions are inconsistent with the discussions during the interview of November 3. For example, the Examiner cites sections of Sakai *et al.* that are related to POS terminal 42 and controller 43 in contending that the feature "inputting said order issuer's payment date into said second input field on said order issuing device." This would lead one to believe that the Examiner is contending that either POS terminal 42 or controller 43 allegedly corresponds to the claimed order issuing device and that the claimed inputting is performed on one of those devices. During the interview, however, the Examiner clarified that it is shopping cart 41 that allegedly corresponds to the claimed order issuing device and that the claimed inputting is allegedly performed in shopping cart 41.

Based on the lack of reasoning to support at least the §102 rejections and the inconsistent reasoning in the Response to Arguments section, Applicant respectfully requests that the Examiner withdraw the Finality of this Office Action and enter the amendments as a matter of right.

In addition, during the interview, the Examiner stated that the claimed transaction condition could depend on the order issuer's payment date, therefore, the recitation "except for said order issuer's payment date" is technically incorrect.

Applicant submits that the phrase, "order issuer's payment date," should be read to modify "commodity order issuance information" (i.e., the issuance information does not have an order issuer's payment date). The Examiner interprets the phrase as modifying the "transaction condition," which is inaccurate based on the recitations of this phrase in the other elements of the

claim. Although the recitation “except for said order issuer's payment date” is accurate as is, Applicant has modified claims 1, 4, 7 and 10 for clarity and precision of language.

III. Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1, 4, 7 and 10 under 35 U.S.C. § 102(b) as being anticipated by Sakai, *et al.* (US 5,630,071) [“Sakai”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a commodity order issuing and accepting method comprising “inputting said order issuer's payment date into said second input field on said order issuing device; and transmitting said order issuer's payment date to said order accepting device.” Based on the telephone interview of November 3, the Examiner contends that shopping cart 41 corresponds to the “order issuing device,” and POS terminal 42 and controller 43 correspond to the claimed “order accepting device.”

Also, as best understood by us during the interview, the Examiner contends that the claimed payment date is inherent because a customer would inherently be required to input a date in the shopping cart 41 to transmit to the POS terminal 42 to purchase the commodities. The Examiner uses Fig. 16 (with the date on the screen) as proof that the purchase (payment) date must be part of shopping cart 41. The Examiner also contends that the claimed first and second electronic documents are inherent since Sakai discloses a plurality of screens and that the claimed first and second input fields are inherent since Sakai discloses input devices such as card reading section 41a, scanner 41b and keyboard 41c.

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP 2100-54. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” MPEP 2100-54 (emphasis added).

Sakai discloses that shopping cart 41 has a card reading section 41a for the input of unique customer information such as a membership number (col. 23, lines 10-13). Sakai also discloses that shopping cart 41 has a scanner 41b and keyboard 41c for input of commodities (col. 23, lines 57-62). There is no disclosure or suggestion that the claimed payment date is inputted into shopping cart 41. The Examiner’s contention that Fig. 16 shows a screen that inherently has a payment date is not supported since the date shown on the screen may just be the current date and time. In fact, Sakai discloses that when a customer enters a commodity, the screen 41m displays the commodity to the customer. Since this date would display whether any payment was made or not, Applicant submits that this date is unrelated to the payment.

The Examiner also contends, as best understood by us, that the date on screen 41m is inherently transmitted to the POS terminal 42 when the purchase is made because Fig. 17, which shows a screen on POS terminal 42, shows a date. Again, Applicant submits that this may just be the current date on the POS terminal 42 itself, therefore, it is not necessarily a payment date.

In addition, Sakai discloses that, when the customer is done inputting the commodities, the shopping cart 41 transmits purchased commodity data as “detailed data including unique customer number information” to the POS terminal 42 (col. 23, line 56 to col. 24, line 17).

There is no suggestion or disclosure that any date, let alone a payment date, is transmitted by the shopping cart 41. Therefore, the Examiner's contention that shopping cart 41 transmits the payment date is mere speculation and not evidence in the record as required by *In re Zurko*, 59 USPQ2d 1693.

Applicant submits that it is entirely possible (and probable) that POS terminal 42 keeps an internal record of date and time and uses its internal date when performing the final settlement. Thus, there would be no reason for the shopping cart 41 to input or transmit the date as contended by the Examiner. Accordingly, the claimed inputting of the order issuer's payment date on the order issuing device and the claimed transmitting of the order issuer's payment date to the order accepting device is not disclosed by Sakai.

Claim 1 recites a commodity order issuing and accepting method comprising "transmitting said first electronic document [comprising first input fields for accepting commodity order issuance information except for an order issuer's payment date] to said order issuing device [from the order accepting device]; ... transmitting a second electronic document on which said transaction condition [corresponding to said commodity order issuance information] is described and which has a second input field for said order issuer's payment date to said order issuing device." (emphasis added). As set forth above, at least two electronic documents are transmitted to the order issuing device.

Sakai, at most, discloses that a request is sent to the shopping cart 41 by POS terminal 42 to send detailed data when the final settlement of accounts is to be performed (col. 25, line 60 to col. 25, line 7). There is no disclosure that POS terminal 42 or controller 43 transmits a first

electronic document that has input fields for accepting commodity order issuance information or a second electronic document that has a transaction condition corresponding to the commodity order issuance information inputted in the first electronic document.

To the extent, other embodiments in Sakai may disclose transmitting information to the shopping cart, this information only corresponds to commodity data such as prices and may, at most, correspond to one electronic transfer to the shopping cart (see col. 3, lines 5-25). There is no disclosure or suggestion that a second electronic document is transmitted to the shopping cart, let alone a second document that has a transaction condition corresponding to the commodity order issuance information inputted in the first electronic document. Therefore, Sakai does not disclose or suggest the claimed transmitting of the first electronic document to the order issuing device and the claimed transmitting of the second electronic document to the order issuing device.

Because claims 4, 7 and 10 recite features similar to those describe above, Applicant submits that these claims are patentable for reasons similar to those given above with respect to claim 1.

IV. Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 2, 3, 5, 6, 8, 9, 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over Sakai in view of Yamamoto, *et al.* (US 6,168,076) [“Yamamoto”]. For at least the following reasons, Applicant traverses the rejection.

Claim 2 recites that the commodity order issuing and accepting method comprises “calculating a reduced price corresponding to said transaction condition and said order issuer's

payment date on said order accepting device.” In response to Applicant’s argument in the previous Office Action that Sakai and Yamamoto (taken alone or in combination) do not disclose or suggest a reduced price based on an order issuer’s payment date, the Examiner contends that “Sakai was cited for the payment date of the order [and] Yamamoto was only cited for the calculating of the reduced price based on the customer’s order.”

Yamamoto discloses a reduced price based on the customer’s order in response to a set-menu item combination (col. 1, lines 45-50). There is no disclosure or suggestion in Yamamoto that a reduced price is based on a payment date. The mere fact that an order was allegedly paid for on a certain date in Sakai does not amount to a suggestion or motivation to combine Sakai with Yamamoto to get the claimed reduced price corresponding to said transaction condition and said order issuer's payment date. At best, Yamamoto would suggest that the customer’s order in Sakai may be reduced based on a set-menu item combination, not the payment date. Applicant submits that the Examiner’s combination of Sakai and Yamamoto could only have been made through improper hindsight.

Because one skilled in the art would not have combined these references, Applicant submits that claims 2, 3, 5, 6, 8, 9, 11 and 12 are patentable (non-obvious) over the prior art.

In addition, because Yamamoto does not cure the deficient teachings of Sakai with respect to claims 1, 4, 7 and 10, Applicant submits that claims 2, 3, 5, 6, 8, 9, 11 and 12 are patentable at least by virtue of their respective dependencies.

Further, the Examiner provides no citation in the prior art for rejecting the features set forth in claims 3, 6, 9 and 12. Since Sakai and Yamamoto (taken alone or in combination) do not

disclose at least the claimed third electronic document, Applicant requests that these rejections be withdrawn.

V. New Claims

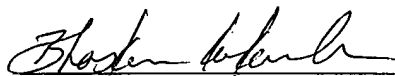
With this amendment, Applicant adds claims 13-32. Applicant submits that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Bhaskar Kakarla
Registration No. 54,627

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 22, 2004